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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/808,137	03/15/2001	Jason French	C3685.0011/P011	4641
24998	7590	05/18/2005	EXAMINER	
DICKSTEIN SHAPIRO MORIN & OSHINSKY LLP			SHAH, ANKEETA	
2101 L Street, NW			ART UNIT	
Washington, DC 20037			PAPER NUMBER	
			3628	

DATE MAILED: 05/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/808,137

Applicant(s)

FRENCH ET AL.

Examiner

Ankeeta Shah

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☐ Claim(s) \_\_\_\_ is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-54 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. ____   |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____  | 6) <input type="checkbox"/> Other: ____                                     |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 101*

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-39 and 52-53 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

Claims 1-39 and 52-53 do not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use a pencil and paper.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-7,10-12,15-17,19-22,26-34 and 37-51 are rejected under 35 U.S.C. 102(e) as being anticipated by Gindlesperger (US PAT 6,397,197).

**Re Claim 1:** Gindlesperger discloses a method for a consumer to obtain a price quote for a product, comprising: submitting a request for a quote by the consumer (i.e. buyer, the buyer transmits an invitation for bid to the vendors, see col7, L39-42) to a staging area (i.e. the area where the PrintProSys.SM. server is, see col4, L57-59), wherein said quote includes at least one product specification (see col9, L24-25 and 36-39); forwarding said request from said staging area to at least one carrier (i.e. vendor, "one or more of the vendors receiving the vendor's invitation for bid", see col8, L3-6); and routing at least one quote from said carrier to said consumer via said staging area in response to said request(see col5, L24-27).

**Re Claim 2:** Gindlesperger further discloses wherein said staging area is controlled by a broker (i.e. PrintProSys.SM. server, see col5, L14-18).

**Re Claim 3:** Gindlesperger further discloses wherein said method is electronic and said staging area is electronically controlled by a broker (i.e. PrintProSys.SM. server, see col5, L15 and col7, L 17-22).

**Re Claim 4:** Gindlesperger further discloses pre-screening said quote in said staging area so as to be at or below a certain maximum prior to routing to said consumer (see col5, L24-30).

**Re Claim 5:** Gindlesperger further discloses said request is forwarded to two or more carriers (i.e. vendors, "one or more of the vendors receiving the vendor's invitation for bid", see col8, L3-6).

**Re Claim 6:** Gindlesperger further discloses wherein each of said carriers (i.e. vendor) routes a quote to said staging area so as to provide at least two quotes to said staging area (see col8, L4-5).

**Re Claim 7:** Gindlesperger further discloses wherein each of said quotes is posted in said staging area and is viewable by each of said carriers (see col5, L33-35).

**Re Claim 10:** Gindlesperger further discloses providing a consumer (i.e. buyer) profile

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to said carrier prior to or while forwarding said request for a quote to said carrier (i.e. to the vendor, see col5, 1-10).

**Re Claim 11:** Gindlesperger further discloses wherein said pre-screening is performed by a broker (i.e. PrintProSys.SM. server, see col5, L14-18).

**Re Claim 12:** Gindlesperger further discloses wherein after said pre-screening, said carrier is notified that its said quote is not at an acceptable level (see col5, L18-27).

**Re Claim 15:** Gindlesperger further discloses wherein said quote is routed within a specified time period (see col10, L24-26).

**Re Claim 16:** Gindlesperger further discloses wherein said quote is the most competitive quote which is routed from a first carrier (see col7, L65-67 and col8, L1-2).

**Re Claim 17:** Gindlesperger further discloses wherein said quote is the most competitive quote from a first carrier in competition with at least one other carrier (see col8, L1-7).

**Re Claim 19:** Gindlesperger discloses A method for at least two carriers to provide a

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price quote for a product in response to a request for said quote from a consumer, comprising: submitting a first price quote from a first carrier to a staging area (i.e. the area where the PrintProSys.SM. server is, see col4, L57-59); reviewing said price quote (see col7, L65-67 and col8, L1-2); and submitting a second price quote from a second carrier to said staging area (see col5, L24-27).

**Re Claim 20:** Gindlesperger further discloses wherein said method is electronic (see col7, L 17-22).

**Re Claim 21:** Gindlesperger further discloses wherein said staging area is electronically controlled by a broker (i.e. PrintProSys.SM. server, see col5, L15 and col7, L 17-22).

**Re Claim 22:** Gindlesperger further discloses wherein said request for said quote is submitted by said consumer (i.e. buyer, see col7, L39) to a staging area (i.e. the area where the PrintProSys.SM. server is, see col4, L57-59).

**Re Claim 26:** Gindlesperger further discloses wherein said broker reviews said price quote (i.e. PrintProSys.SM. server, see col5, L14-18).

**Re Claim 27:** Gindlesperger further discloses wherein said step of reviewing said price quote comprises assessing whether said price quote is at or below a pre-determined

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maximum(see col8, L5-10).

**Re Claim 28:** Gindlesperger further discloses wherein said step of reviewing further comprises rejecting a price quote which is above said pre-determined maximum (see col5, L18-27).

**Re Claim 29:** Gindlesperger further discloses comprising pre-registering said carrier (i.e. the vendor) with said broker (i.e. PrintProSys.SM. server) prior to submitting said first price quote (see col7, L17-19).

**Re Claim 30:** Gindlesperger further discloses wherein after said pre-registration said carrier is notified and selected to participate in said method by said broker (i.e. the PrintProSys.SM. server sends the vendor an invitation for bid, see col7, L 49-65).

**Re Claim 31:** Gindlesperger further discloses comprising establishing certain date and time parameters for said method (see col10, L24-29).

**Re Claim 32:** Gindlesperger further discloses wherein said method is conducted within a specified time period (see col10, L24-26).

**Re Claim 33:** Gindlesperger further discloses further comprising notifying said carrier of a starting time and an ending time corresponding to said specified time period (see



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col10, L24-29 ).

**Re Claim 34:** Gindlesperger further discloses further comprising notifying said carrier of the time remaining within said specified time period(see col10, L24-38 ).

**Re Claim 37:** Gindlesperger further discloses wherein said price quote includes a qualification (i.e. the vendor capability attributes, see col6, L65-67).

**Re Claim 38:** Gindlesperger further discloses wherein said qualification includes conditional terms pertaining to said product (i.e. the vendor capability attributes, see col6, L65-67 and col7, L1-16).

**Re Claim 39:** Gindlesperger discloses a method of brokering a transaction, comprising: receiving at least one request for a price quote from a consumer (i.e. buyer, see col7, L39) for a product the consumer is interested in purchasing(i.e. print); receiving at least one price quote from a first carrier(i.e. vendor) of said product(see col8, L3); receiving a second quote from a second carrier(i.e. vendor) of said product; and posting said request and said price quotes to a staging area(i.e. the area where the PrintProSys.SM. server is, see col4, L57-59and col8, L6-7).

**Re Claim 40:** Gindlesperger further discloses wherein said method is electronic and

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said transaction is an on-line auction (see col7, L 17-22 and col8, L3-10).

**Re Claim 41:** Gindlesperger further discloses wherein said staging area is an electronic viewing area (i.e. PrintProSys.SM. server, see col5, L15 and col7, L 17-22).

**Re Claim 42:** Gindlesperger discloses a system for conducting an on-line auction, comprising: an electronic staging area(i.e. the area where the PrintProSys.SM. server is, see col4, L57-59and col8, L6-7) linked to a broker interface (i.e. the PrintProSys.SM. server) wherein said staging area(i.e. the area where the PrintProSys.SM. server is, see col4, L57-59and col8, L6-7) displays requests for price quotes on products submitted by consumers(i.e. buyer, see col7, L39) ,and also displays responses to said requests by one or more carriers(i.e. vendor) of said products(see col8, L6-7).

**Re Claim 43:** Gindlesperger further discloses comprising a customer interface and a communications link between said customer interface and said broker interface (see Fig1).

**Re Claim 44:** Gindlesperger further discloses comprising a carrier interface and a communications link between said carrier interface and said broker interface (see Fig.1).

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**Re Claim 45:** Gindlesperger further discloses wherein said staging area (i.e. the area where the PrintProSys.SM. server is, see col4, L57-59 and col8, L6-7) is controlled by a broker through said broker interface (i.e. the PrintProSys.SM. server).

**Re Claim 46:** Gindlesperger further discloses wherein said broker interface includes a database (see col7, L17-22).

**Re Claim 47:** Gindlesperger further discloses wherein said broker interface comprises means for conducting an on-line auction (see col7, L17-22).

**Re Claim 48:** Gindlesperger further discloses wherein said means further comprises means for posting price quotes in said staging area received during said on-line auction (see col8, L6-9).

**Re Claim 49:** Gindlesperger further discloses wherein said staging area further displays a price quote matrix (i.e. the data with the vendors information is stored by the PrintProSys.SM.server, see col7, L17-22 and col8, L6-7).

**Re Claim 50:** Gindlesperger further discloses wherein said system comprises at least two carrier interfaces (i.e. point at which the connection is made with the vendors, see col7, L17-22).

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**Re Claim 51:** Gindlesperger further discloses wherein said system comprises at least two customer interfaces (i.e. point at which the connection is made with the buyer, see col8, L8-17).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 8,9,18,23-25 and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gindlesperger in view of Ausubel (US PAT 5,905,975).

**Re Claim 8:** Gindlesperger does not disclose wherein at least one of said carriers revises said quote after viewing said quotes of other carriers.

Ausubel discloses wherein at least one of said carriers revises said quote after viewing said quotes of other carriers (see col2, L 3-8).

Thus it would be obvious to one having ordinary skill in the art at the time of invention was made to modify the method of Gindlesperger by adapting the teaching of Ausubel to provide the users with the lowest bid price.

**Re Claim 9:** Gindlesperger further discloses wherein the most competitive of said price quotes is routed to said consumer (see col8, L8-10).

**Re Claim 18:** Gindlesperger does not disclose wherein each of said carriers submits a quote in response to another quote by another of said carriers.

Ausubel discloses wherein each of said carriers submits a quote in response to another quote by another of said carriers (see col2, L3-8).

Thus it would be obvious to one having ordinary skill in the art at the time of invention was made to modify the method of Gindlesperger by adapting the teaching of Ausubel to provide the users with the lowest bid price.

**Re Claim 23:** Gindlesperger discloses wherein said method is an auction (see col8, L3-15).

Gindlesperger does not disclose wherein more than two carriers submit a price quote such that said carriers are in competition with one another.

Ausubel discloses wherein more than two carriers submit a price quote such that said carriers are in competition with one another (see col2, L3-8).

Thus it would be obvious to one having ordinary skill in the art at the time of invention was made to modify the method of Gindlesperger by adapting the teaching of Ausubel to provide the users with the lowest bid price.

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**Re Claim 24:** Gindlesperger does not disclose wherein said first carrier submits a first price quote and said second carrier submits a second price quote after reviewing said first price quote.

Ausubel discloses wherein at least one of said carriers revises said quote after viewing said quotes of other carriers (see col2, L3-8).

Thus it would be obvious to one having ordinary skill in the art at the time of invention was made to modify the method of Gindlesperger by adapting the teaching of Ausubel to provide the users with the lowest bid price.

**Re Claim 25:** Gindlesperger further discloses wherein the most competitive of said price quotes is transmitted to said consumer (see col8, L8-10).

**Re Claim 52:** Gindlesperger discloses a method for a broker to conduct an on-line auction, comprising: pre-registering at least one customer (i.e. buyer) who is interested in obtaining a competitive price quote on a product; pre-registering at least two carriers (i.e. vendors) of said product (i.e. print); establishing a time for said auction; having said at least one customer submit a request for a price quote during said auction time (i.e. buyer, see col7, L39); having a first carrier submit a first price quote in response to said request(see col8, L3);

Gindlesperger does not disclose posting said first price quote for viewing by at least one of said customer and said carriers; having a second carrier submit a second price quote in response to said request and to said first price quote; and posting said second price quote for viewing by at least one of said customer and said carriers.

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Ausubel discloses posting said first price quote for viewing by at least one of said customer and said carriers (see col1, L57-61); having a second carrier submit a second price quote in response to said request and to said first price quote (see col1, L57-61); and posting said second price quote for viewing by at least one of said customer and said carriers (see col1, L57-61).

Thus it would be obvious to one having ordinary skill in the art at the time of invention was made to modify the method of Gindlesperger by adapting the teaching of Ausubel to provide the users with the lowest bid price.

6. Claims 13,14,35,36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gindlesperger in view of Howorka (US PAT 6,282,521).

**Re Claim 13:** Gindlesperger does not disclose wherein said request for a quote is submitted anonymously so that said carrier does not know the identity of said consumer.

Howorka discloses wherein said request for a quote is submitted anonymously so that said carrier does not know the identity of said consumer (see col1, L57-61).

Thus it would be obvious to one having ordinary skill in the art at the time of invention was made to modify the method of Gindlesperger by adapting the teaching of Howorka to provide the users with the lowest bid price.

**Re Claim 14:** Gindlesperger further discloses wherein said request is submitted along with a profile of said customer, wherein said profile contains selected actuarial facts

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about said customer or one or more employees of said customer (see col5, L1-6).

**Re Claim 35:** Gindlesperger does not disclose wherein said carrier does not know the identity of said consumer.

Howorka discloses wherein said request for a quote is submitted anonymously so that said carrier does not know the identity of said consumer (see col1, L57-61).

Thus it would be obvious to one having ordinary skill in the art at the time of invention was made to modify the method of Gindlesperger by adapting the teaching of Howorka to provide the users with the lowest bid price.

**Re Claim 36:** Gindlesperger further discloses further comprising notifying said carrier (i.e. the vendor) that its quote is being transmitted to said consumer (see col8, L3-20).

7. Claims 53 is rejected under 35 U.S.C. 103(a) as being unpatentable Gindlesperger in view of Ausubel, further in view of Kelly (US PAT 5,806,042).

Gindlesperger discloses: a method for competitively quoting a rate of return for premiums, comprising: pre-registering at least two carriers (i.e. vendors, see col9, L21-26); establishing an auction time and period (see col7, L39); submit a request for a quote during said auction; having a first carrier submit a first quote in response to said request (see col8, L7-8); posting said quote (see col8, L3-4);



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Gindlesperger does not disclose: having a second carrier submit a second quote in response to said request and to said response from said first carrier; and posting said second quote.

Ausubel discloses: having a second carrier submit a second quote in response to said request and to said response from said first carrier (see col1, L57-61); and posting said second quote (see col1, L57-61).

Neither Gindlesperger nor Ausubel disclose bank-owned life insurance (BOLI).

Kelly discloses bank-owned life insurance (BOLI).

Thus it would be obvious to one having ordinary skill in the art at the time of invention was made to modify the method of Gindlesperger and Ausubel by adapting the teaching of Kelly to provide the users the best possible price on life insurance.

8. Claims 54 is rejected under 35 U.S.C. 103(a) as being unpatentable

Gindlesperger in view of Kelly.

Gindlesperger discloses: An electronic system useful in conducting an on-line, comprising: a broker-controlled staging area for displaying responses received to said requests during an on-line auction (see col7, L39 and col8, L6-7), wherein said staging area (i.e. the area where the PrintProSys.SM. server is, see col4, L57-59 and col8, L6-7) is in communication with a broker interface (i.e. the PrintProSys.SM. server).

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Gindlesperger does not disclose bank-owned life insurance (BOLI).

Kelly discloses bank-owned life insurance (BOLI).

Thus it would be obvious to one having ordinary skill in the art at the time of invention was made to modify the method of Gindlesperger by adapting the teaching of Kelly to provide the users the best possible price on life insurance.

### **Conclusion**

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited but not relied upon prior art discloses:


- <https://www.insureme.com>
- A method for On-Line market environment (PG PUB 2001/0027436).
- Computerized quotation system and method (US PAT 5,584,178).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ankeeta Shah whose telephone number is (571) 272-7111. The examiner can normally be reached on M-F 8:30AM - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung Sough can be reached on (571) 272-6799. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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